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Confirmation No.: 4012

Filed: November 2, 2001

First Inventor: Camellia W. Adams

For: APO-2 RECEPTOR

Group Art Unit: 1646

Examiner: Eileen B. O'Hara

Attorney Ref. 22338-00904

**CERTIFICATE OF TRANSMISSION UNDER 37 C.F.R. § 1.8**

I CERTIFY THAT THE FOLLOWING DOCUMENTS ARE BEING TRANSMITTED TO THE USPTO AT  
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1. Petition Under 37 C.F.R. § 1.181 and/or 1.182 (5 pages)

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## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patent No. 7,314,619	Group Art Unit: 1646
Application Serial No.: 10/052,798	Examiner: Eileen B. O'Hara
Applicant: Camelia W. ADAMS	Attorney Docket No: 22338-00904 (P1101R2D1)
Filed: November 2, 2001	
Confirmation No.: 4012	
Title: APO-2 RECEPTOR	

Mail Stop: Petition  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**PETITION UNDER 37 C.F.R. § 1.181 and/or 1.182**

Sir:

Applicant filed a request for reconsideration of patent term adjustment under 37 C.F.R. § 1.705(d) for U.S. Patent No. 7,314,619 (the '619 patent) on January 16, 2008. In a decision mailed on December 17, 2008, the Office dismissed applicant's request. The Decision indicated, *inter alia*, that the period of adjustment of 81 days attributable to grounds specified in 37 C.F.R. § 1.702(a)(1) overlapped with the period of adjustment of 1155 days attributable to grounds specified in 37 C.F.R. § 1.702 (b). In view of that determination, the decision indicated that it was proper to not enter an additional period of adjustment for PTO delay beyond 1155 days.

As explained in detail below, applicant believes the PTO's determination is contrary to the plain language of 35 U.S.C. § 154(b). In particular, the PTO erred in the determination of patent term adjustment for the '619 patent by erroneously treating the period of "B Delay" as overlapping with the "A Delay" where there was no actual overlap for the time periods running for the A Delay and the B Delay.

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Applicant believes that this petition is timely filed in view of the fact that the Office gave applicant two months from the mailing date of December 17, 2008 to respond to its decision dismissing applicant's request.

Applicant believes that this petition requires the petition fee set forth in §1.17(f) (\$400.00). The Director is authorized to debit this amount, in addition to any other fees necessary for entry or consideration of this paper, and credit any overpayments credited to our Deposit Account No. 18-1260.

**Facts**

1. In determining the patent term adjustment, the Director is required to extend the term of a patent for a period equal to the total number of days attributable to delay by the PTO under 35 U.S.C. § 154(b)(1), as limited by any overlapping periods of delay by the PTO as specified under 35 U.S.C. § 154(b)(2)(A), any disclaimer of patent term by the applicant under § 154(b)(2)(B), and any delay attributable to the applicant under 35 U.S.C. § 154(b)(2)(C).
2. Genentech petitioned the Office to reconsider its patent term adjustment period (741 days) for the '619 patent on January 16, 2008, and complied with the applicable regulatory requirements.
3. In its request, applicant noted, *inter alia*,
  - U.S. Patent No. 7,314,619 issued from U.S. application serial no. 10/052,798 (the '798 application) on January 1, 2008. The '798 application was filed on November 2, 2001.
  - The '619 patent is not subject to a terminal disclaimer.
  - The net PTA recorded in the PAIR system is 741 days. This period reflects the PTO's determination that there were 1155 days of PTO delay and 414 days of applicant delay.
  - The PTO has correctly determined that there was a period of PTO delay of 81 days under §§ 1.702(a)(1) and 1.703(a)(1) due to the failure of the PTO to mail a communication

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within 14 months of filing. This period of 81 days is the period between January 2, 2004 and March 24, 2004.

- The dated the "Three Years" delay under § 1.703(b) and §1.702(b) began to accrue is November 3, 2004 (i.e., the day following the third anniversary of the filing date).
- The "Three Years" delay under § 1.703(b) and §1.702(b) running from November 3, 2004 to January 1, 2008 and the examination delay under §1.703(a)(1) running from January 2, 2004 and March 24, 2004 do not overlap.
- The reductions under § 1.704, in the sum of 414 days, were correctly determined by the PTO.

4. On December 17, 2008, the Office denied applicant's petition—11 months and 16 days after the '619 patent issued, and 11 months after applicant filed its request for reconsideration of the initial patent term adjustment determination.

5. In the decision dismissing applicant's request for reconsideration of the patent term adjustment for the '619 patent, the Office stated that "the period of adjustment under 37 CFR 1.703(b) was properly calculated as 1155 days, the number of days beginning on the day after the date that is three years after the date on which the application was filed under 35 U.S.C. 111(a), November 3, 2004, and ending on the date a patent was issued, January 1, 2008."

6. The Office further stated in its decision that "in considering the overlap [of B Delay and A delay], the entire period during which the application was pending...and not just the period beginning three years after the actual filing date of the application, is the period of delay under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay overlap under 35 U.S.C. 154(b)(2)(A).

#### Discussion

Applicant agrees with the Office's decision that the "three years delay" (or "B Delay") under §1.703(b) and §1.702(b) was correctly calculated as 1155 days. However, applicant

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disagrees with the Office that applicant is not entitled to an additional period of examination delay under § 1.702(a)(1) and 1.703(a)(1) ("A Delay") in the amount of 81 days.

In its decision on applicant's request for reconsideration, instead of correctly crediting applicant the sum of the nonoverlapping "A Delay" and "B Delay" periods (i.e., 1236 days), the Office credited only the greater of the two delays (i.e., the "B Delay" of 1155 day). The Office's justification for doing so is based on a construction of 35 U.S.C. § 154(b) that was specifically rejected in *Wyeth v. Dudas*, 88 U.S.P.Q.2d 1538, 2008 WL 4445642 (D.D.C. Sep. 30, 2008), as being at odds with language of the statute. In particular, in the Office's opinion, any administrative delay under § 154(b)(1)(A) overlaps any 3-year maximum pendency delay under § 154(b)(1)(B) and the applicant gets credit for "A delay" or for "B delay," whichever is larger, but never A + B. According to the Court in *Wyeth*, "[t]he problem with the PTO's construction is that it considers the application delayed under § 154(b)(1)(B) during the period before it has been delayed." The Court explained that "[t]he only way that [A and B] periods of time can 'overlap' is if they occur on the same day." The Court further noted that "'B Delay' begins when the PTO has failed to issue a patent within three years, not before," and therefore it is not proper to "run[] the 'period of delay' under subsection (B) from the filing date of the patent application."

Applicant's argument in its request for reconsideration filed January 16, 2008 rests on the same footing as advanced by *Wyeth*, and which the Court in *Wyeth* accepted as the proper way to interpret the statute. In short, that argument was that applicant is entitled to both the A Delay (81 days) and the B Delay (1155 days) in this application because they do not overlap.

### Conclusion

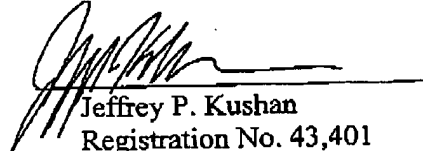
Applicant respectfully requests that the Office reconsider its decision to dismiss applicant's request for an adjustment to its patent term extension. For the reasons set forth above, applicant believes it is entitled to an additional adjustment of the term of the '619 patent under 35 U.S.C. § 154(b)(1)(A), in the amount of 81 days, which is the number of days attributable to "A Delay", and which does not overlap with the "B Delay." Thus, applicant requests that the PTA be corrected to a total of 822 days.

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Applicant notes that the Office has appealed the District Court for the District of Columbia's decision in *Wyeth v Dudas*, and that the case is still pending. Accordingly, the Director may consider that it is appropriate to defer action on the present petition until the appellate court has made a decision as to whether the Office's present method of determining PTA (crediting applicant's for "A delay" or for "B delay," whichever is larger, but never A + B ) is contrary to 35 U.S.C. § 154(b).

Respectfully submitted,

February 17, 2009

  
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